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*h.k.*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/182,033    10/29/98    BURNS

D    2391

022208  
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LM02/0427

EXAMINER

KAZIMI, H

ART UNIT

PAPER NUMBER

2765

DATE MAILED:

04/27/00

*8*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/182,033**

Applicant(s)  
**Burns**

Examiner  
**Hani Kazimi**

Group Art Unit  
**2765**



☒ Responsive to communication(s) filed on Feb 3, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-29 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-29 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

1. This communication is in response to the amendment filed on February 3, 2000. The rejections cited are as stated below:

### ***Status of Claims***

2. Of the original claims 1-22, claims 1, 2, 4, 5, 8, 9, 11, 12, 14, and 21 have been amended, and claims 23-29 have been added in the preliminary amendment filed on September 29, 1999. In the amendment filed on February 3, 2000, claims 1, 2, 4-9, 11-14, 18, 19, 21-24, and 29 have been amended. Therefore, claims 1-29 are under prosecution in this application.

### ***Summary of this Office Action***

3. Applicants' arguments filed on February 3, 2000 have been fully considered, and discussed in the next section below or within the following rejection are not deemed to be persuasive. Therefore, claims 1-29 are rejected under 35 U.S.C. § 102(b), and 35 U.S.C. § 103 as being unpatentable over the art cited below, and Applicants' request for allowance is respectfully denied.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 4-9, 11-15, and 17-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Nichtberger et al. US Pat. No. 4,882,675 hereinafter "Nichtberger".

Claims 1, 8, 14, 21, and 22, Nichtberger discloses a method for electronic processing of discount coupons (abstract) comprising:

reading coupon information of a plurality of consumers from unutilized clipped coupons with a bar code scanner and sending the unutilized coupon information to a data base where the unutilized coupon information is attributed to a specific consumer (column 29, lines 32-68);

scanning purchase information of products chosen by a specific consumer at a check out register having the capability to identify the specific consumer in relation to the coupon data base (column 17, lines 29-48);

reconciling the unutilized coupon information with the register information and providing any applicable discount to the consumer at the register (column 17, lines 48-61);

updating the data base to reflect purchases and discounts given at the register (column 18, lines 5-41);

sending the utilized coupon information and register information to a source for reimbursement to vendor (column 18, lines 5-41); and

sending specific consumer information relating to either purchases, coupons or both to a data center (column 18, lines 5-41).

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Claims 2, 9, and 15, Nichtberger discloses access means for a consumer to access the coupon data base to review their unutilized coupon information (column 29, lines 13-68).

Claims 4, 11, and 17, Nichtberger discloses access means for the consumer to access their unutilized coupon information in the coupon data base at the store (column 29, lines 32-68).

Claims 5, 12, and 18, Nichtberger discloses access means comprises a printout of their unutilized coupon information in the coupon data base (column 5, lines 1-16, and column 11, line 35-63).

Claims 6, 7, 13, and 19, Nichtberger discloses the utilization of a code scanner to enter the unutilized coupon information into the coupon data base (column 29, lines 32-68).

Claim 20, Nichtberger discloses that the coupon database is shared by more than one store (fig. 1, and column 29, lines 13-68).

Claims 23, and 24, Nichtberger discloses the means for sorting the unutilized coupon information (column 29, lines 32-68).

Claims 25-27, Nichtberger discloses a plurality of check-out registers associated with a plurality of stores and wherein the coupon database is centralized to allow access by the plurality

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of stores (fig. 1, and column 29, lines 13-68).

Claim 28, Nichtberger discloses the means to send consumer purchase information to a manufacturer (column 18, lines 5-41).

Claim 29, Nichtberger discloses the means for electronically sending coupons from a manufacturer to the specific consumer by adding unutilized manufacturer coupon information to the coupon database (column 18, lines 5-41, and column 29, lines 32-68).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 3, 10, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nichtberger et al. US Pat. No. 4,882,675 hereinafter "Nichtberger" in view of Fajkowski US Pat. No. 5,905,246.

Claims 3, 10, and 16, Nichtberger fails to teach that the access means includes access through the Internet.

Fajkowski discloses that the access means includes access through the Internet (column 6, lines 20-43).

It would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of Nichtberger to include the use of the Internet, because it provides convenience to the user by allowing the user to access various supermarket CDR units, and review, select, and retrieve coupon information directly from the operations center.

#### *Response to Arguments*

9. Applicant's arguments with respect to claims 1-29 have been considered but are moot in view of the new ground(s) of rejection. The response to Applicant's arguments with respect to the claims is mentioned above in the 35 U.S.C. 102, and 103 rejections of this office action.

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***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a) Nichtberger et al. US Patent Re. 34,915 Apr. 25, 1995.
- b) De Lapa et al. US Patent 5,822,735 Oct. 13, 1998.
- c) Fredregill et al. US Patent 5,923,016 Jul. 13, 1999.
- d) Boushy et al. US Patent 6,003,013 Dec. 14, 1999.
- e) Powell US Patent 6,012,038 Jan. 4, 2000.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

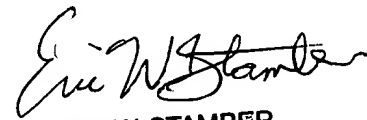
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen MacDonald, can be reached at (703) 305-9708.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 308-5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Hani.Kazimi

April 20, 2000

  
ERIC W. STAMBER  
PRIMARY EXAMINER